



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,263	10/11/2000	Milan Mrksich	7814/42	8463

757 7590 12/24/2003

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60611

EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/689,263

Applicant(s)

MRKSICH ET AL.

Examiner

David M. Naff

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: Form 1449 of 12/1/03 attached.

David M. Naff
Primary Examiner
Art Unit: 1651

Art Unit: 1651

ATTACHMENT TO FORM PTOL-303

The rejection of claims 19-36, 41, 43, 44 and 49-58 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Luk et al is withdrawn.

The rejection of claims 19, 29, 30, 36 and 41 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chapman et al is maintained.

In the amendment of 12/1/03, applicants state that Declarations pursuant to 37 CFR 1.131 are attached of inventors Milan Mrksich and Yan Yeung Luk. However, only a declaration of Milan Mrksich was attached to the amendment. A 37 CFR 1.131 Declaration must be signed by all of the inventors.

Additionally, if signed by both inventors, the declaration can overcome Chapman et al only with respect to the species shown by Figure 1 of the Luk et al article relied on as evidence in the declaration.

The rejection of claims claims 29, 36, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mrksich et al (A18) in view of Hodneland et al (A7), Houseman et al (A9) and Sigal et al (A25), and if necessary in further view of Deng et al (A3) or Hodneland et al (A8) is maintained.

As stated in the previous office action, the claims are not limited to a particular cell patterning test, and the claims can

Art Unit: 1651

be performed with any test that one considers a cell patterning test. The result from a cell patterning test will depend on the conditions used and how the test is carried out. Certain types of cells other than used in the test in the specification may not fail a test at 12 days. While claim language may be interpreted based on definitions in the specification as stated in the MPEP, the definitions cannot be relied on for reading into the claim limitations that are not in the claims. Metes and bounds of the invention are set forth by the claims and not by the specification. Interpreting claim language is not the same as limiting the claims.

Applicants refer to previous arguments in the amendment of 5/13/03 that the references do not disclose groups that will meet the cell patterning test. However, Hodneland et al (A7) and Houseman et al (A9) disclose monolayers of alkanethiolates terminated in a mixture of a tri(ethylene glycol) moiety and another moiety. In Figure 1 of Hodneland et al, a terminal group is a quinone propionic ester which can have a tethered ligand. In Houseman et al, the terminal group is glucose (Figure 1). These mixed SAMs have terminal groups in addition to the ethylene glycol, and it cannot be assumed these mixed SAMs will provide the same results as the when only ethylene glycol is a terminal group. Further note that in Hodneland et

Art Unit: 1651

al (A8) (Figure 2), a terminal group is present in addition to ethylene glycol.

The rejection of claims 19-36, 41, 43, 44 and 49-58 under 35 U.S.C. 103(a) as being unpatentable over Mrksich et al (A18), Hodneland et al (A7), Houseman et al (A9) or Sigal et al (A25) in view of Chapman et al is maintained.

As set forth above, the 37 CFR 1.131 Declaration fails to remove Chapman et al as a reference.

The rejection of claims 19-36, 41, 43, 44 and 49-58 as provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-117 of copending Application No. 09/923,760 or claims 1-41 of copending application 09/797,166 in view of Chapman et al is maintained.

As set forth above the 37 CFR 1.131 Declaration does not remove Chapman et al as a reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 703-308-0520. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 703-308-4743. The fax phone number for the

Application/Control Number: 09/689,263

Page 5

Art Unit: 1651

organization where this application or proceeding is assigned is
703-872-9306.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is 703-308-0196.



David M. Naff
Primary Examiner
Art Unit 1651

DMN
12/17/03